

Serial No.: 10/822,004
Docket No.: 101-1028
Amendment dated January 10, 2006
Reply to the Office Action of November 3, 2005

REMARKS

Introduction

Applicants note with appreciation the Examiner's indication that claims 19-21 are allowed and that claims 6-13 and 23 would be allowed if rewritten in independent form.

Upon entry of the foregoing amendment, claims 1-29 are pending in the application. Claim 22 has been amended. No claims have been cancelled. New claims 25-29 have been added. No new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are requested.

Rejection under 35 USC §102

Claims 22 and 24 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,802,427 to Sawada et al. Applicants respectfully request reconsideration of these claims for at least the following reasons.

Applicants submit that Sawada et al. is directed to a printer having a body 1 including a stationery frame 2 and a movable frame 5 that is rotatable about a shaft 81 such that the body 1 can be opened and closed. See Sawada et al. col. 5, lines 38-41 and FIG. 4. The movable frame 5 accommodates an intermediate transfer unit 40 and a photosensitive unit 10 such that the photosensitive unit 10 and the intermediate transfer unit 40 are detached from the movable frame 5 when the body 1 is in an open state. See Sawada et al. col. 5, lines 52-59 and FIG. 4. The photosensitive unit 10 and the intermediate transfer unit 40 are positioned inside the body 1 when the movable frame 5 is closed with respect to the stationery frame 2. See Sawada et al. col. 6, lines 4-10. Thus, as the movable frame 5 in Sawada et al. is closed with respect to the stationery frame 2, the photosensitive unit 10 and the intermediate transfer unit 40 are both simultaneously positioned in the body 1 by the movement of the movable frame 5. Since the photosensitive unit 10 and the intermediate transfer unit 40 are both simultaneously positioned in the body 1 when the movable frame 5 is moved to close the body 1, Sawada et al.'s intermediate transfer unit 40 is not "mountable on the main frame independently from the

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photosensitive drum unit," as presently recited in independent claim 22 of Applicants' invention. Accordingly, Applicants respectfully submit that Sawada et al. does not disclose, among other things, "an intermediate transfer unit having a transfer medium to which the toner image is transferred from the photosensitive drum, and mountable on the main frame independently from the photosensitive drum unit and adjacent thereto," as presently recited in independent claim 22.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). "The elements must be arranged as required by the claim..." In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Further, in the event that the Office Action is relying on the theory of inherency in any manner, "the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See also MPEP 2112. Accordingly, since Sawada et al. does not explicitly or inherently teach every element as presently recited in independent claim 22, Sawada et al. cannot be properly used to reject independent claim 22 under 35 U.S.C. § 102. Therefore, it is respectfully submitted that independent claim 22 is allowable over Sawada et al., and withdrawal of this rejection and allowance of this claim are earnestly solicited.

Regarding claim 24, it is respectfully submitted that for at least the reason that claim 24 depends from independent claim 22, and therefore contains each of the features as presently recited in this claim, claim 24 is therefore also patentable over Sawada et al. Accordingly, withdrawal of the rejection and allowance of this claim are also earnestly solicited.

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Rejection under 35 USC §103

Claims 1-3 and 5 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,807,393 to Sameshima et al. Applicants respectfully traverse this rejection for at least the following reasons.

At page 3, item 5 of the Office Action of November 3, 2005, the Examiner takes the position that "Sameshima teaches an electrophotographic printer comprising ... a photosensitive drum unit vertically detachably installed on the main frame...and an intermediate transfer unit vertically detachably installed on the main frame... wherein the intermediate transfer unit is installed above the photosensitive drum unit (figure 1, 8)..."

Applicants submit that Sameshima et al. is directed to an image forming unit 5 that is detachably mounted to a main body A of an image forming apparatus including a photosensitive drum unit 20 (having a photosensitive drum 1) and an intermediate transfer belt unit 21 (having an intermediate transfer belt 5a). See Sameshima et al. col. 3, lines 32-45; col. 5, lines 45-56; and FIGS. 1 and 2. The Examiner appears to rely on the transfer belt unit 21 to teach "an intermediate transfer unit," as recited in independent claim 1. However, it is evident from FIGS. 2, 3, 5, 8-10, 13, and 14 of Sameshima et al. that the intermediate transfer belt unit 21 is disposed below the photosensitive drum unit 20. Thus, contrary to the Examiner's position, the intermediate transfer belt unit 21 is not installed "above the photosensitive drum unit," as recited in independent claim 1. Since the intermediate transfer belt unit 21 shown in Sameshima et al. is not "installed above the photosensitive drum unit," Sameshima et al. fails to teach, among other things, "a photosensitive drum unit..." and "an intermediate transfer unit...wherein the intermediate transfer unit is installed above the photosensitive drum unit," as recited in independent claim 1 of Applicants' invention.

Furthermore, the Examiner acknowledges that Sameshima et al. "does not teach an independently detachable or installable (separable) intermediate transfer unit." See Office Action of November 3, 2005 page 4, 1st paragraph. The Examiner then maintains that "However, it would have been obvious...to make the intermediate transfer unit separable from the photosensitive drum at the time of detaching/installing since it has been held to be within ordinary skill in the art to make an combined [sic] unit separable." See Office Action of

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November 3, 2005 page 4, 1st paragraph.

The Examiner apparently cites the case of *In re Dulberg* in an effort to support the proposition that it would have been obvious to make the photosensitive drum unit 20 separate from the intermediate transfer belt unit 21 in Sameshima et al. However, Sameshima et al. itself actually describes that the image forming unit 5 can be separated into the photosensitive drum unit 20 and the intermediate transfer belt unit 21 as shown in FIGS. 6 and 7. See Sameshima et al. col. 7, lines 23-26. Even though Sameshima et al. shows that the image forming unit 5 can be separated into the photosensitive drum unit 20 and the intermediate transfer belt unit 21 once the image forming unit 5 is removed from the printer body A, Sameshima et al. does not teach, among other things, “a photosensitive drum unit vertically detachably installed on the main frame...” and “an intermediate transfer unit vertically detachably installed on the main frame independently from the photosensitive drum unit...,” as recited in independent claim 1 of Applicants’ invention. Furthermore, *In re Dulberg* does not teach the features that Sameshima et al. lacks. Accordingly, Applicants submit that Sameshima et al. and *In re Dulberg*, either alone or in combination, fail to teach or suggest each of the features as recited in independent claim 1.

In addition, contrary to the Examiner’s position, *In re Dulberg* does not provide any evidence of why one of ordinary skill in the art would have been motivated to modify the teachings of Sameshima et al., since Sameshima et al. itself describes that the photosensitive drum unit 20 is separable from the intermediate transfer belt unit 21. Thus, the Examiner has failed to provide a proper suggestion or motivation to modify Sameshima et al.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Since (1) Sameshima et al. fails to teach or suggest each element as recited in independent claim 1 and (2) the Examiner has not provided a proper suggestion or motivation to modify Sameshima et al., Sameshima et al. cannot be properly used to reject independent claim 1 under 35 U.S.C. §

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103. Therefore, it is respectfully submitted that independent claim 1 is allowable over Sameshima et al., and withdrawal of this rejection and allowance of this claim are earnestly solicited.

Regarding claims 2, 3, and 5, it is respectfully submitted that for at least the reason that each of claims 2, 3, and 5 depends from independent claim 1, and therefore contain each of the features as recited in this claim, claims 2, 3, and 5 are therefore also patentable over Sameshima et al. Accordingly, withdrawal of the rejection and allowance of these claims are also earnestly solicited.

Claims 14-18 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sameshima et al. and further in view of U.S. Publication No. 2004/0170450 to Hamano et al. Applicants traverse this rejection for at least the following reason.

Claims 14-18 directly or indirectly depend from independent claim 1, and therefore include the features as recited in independent claim 1. The Examiner acknowledges that Sameshima et al. does not teach a transfer device that moves in and out of contact with a drum. See Office Action of November 3, 2005 page 4, item 6. However, the Examiner relies on Hamano et al. to allegedly teach or suggest the features admittedly lacking in Sameshima et al. See Office Action of November 3, 2005 page 4, item 6. Applicants respectfully submit that even if it is assumed that it were proper to combine Sameshima et al. with Hamano et al. to describe a transfer device that moves in and out of contact with a drum, as alleged by the Examiner, Sameshima et al. and Hamano et al., either separately or in combination, fail to teach or suggest, among other things, “a photosensitive drum unit vertically detachably installed on the main frame...” and “an intermediate transfer unit vertically detachably installed on the main frame independently from the photosensitive drum unit...” as recited in independent claim 1 of Applicants’ invention. Accordingly, claims 14-18 are patentable over the references relied upon by the Examiner, and withdrawal of the rejection and allowance of these claims are earnestly solicited.

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Claim 4 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Sameshima et al. and further in view of U.S. Patent No. 4,837,598 to Nonami. Applicants traverse this rejection for at least the following reason.

Claim 4 indirectly depends from independent claim 1, and therefore includes the features as recited in independent claim 1. The Examiner acknowledges that Sameshima et al. does not teach an eraser device. See Office Action of November 3, 2005 page 4, item 7. However, the Examiner relies on Nonami to allegedly teach or suggest the features admittedly lacking in Sameshima et al. See Office Action of November 3, 2005 page 4, item 7. Applicants respectfully submit that even if Nonami does in fact describe an eraser device, as alleged by the Examiner, Sameshima et al. and Nonami, either separately or in combination, fail to teach or suggest, among other things, “a photosensitive drum unit vertically detachably installed on the main frame...” and “an intermediate transfer unit vertically detachably installed on the main frame independently from the photosensitive drum unit...,” as recited in independent claim 1 of Applicants’ invention. Accordingly, claim 4 is patentable over the references relied upon by the Examiner, and withdrawal of the rejection and allowance of this claim are earnestly solicited.

New Claims

Claim 25-29 have been newly added. New independent claim 25 recites similar features as those recited in independent claims 1, 19, and 22, for example, “a photosensitive drum unit having a photosensitive drum on which an electrostatic latent image is formed, and slidably mounted on or dismounted from the frame in a vertical direction” and “a development unit having a developing roller to supply toner to the photosensitive drum to develop the electrostatic latent to form a toner image, and slidably mounted on or dismounted from the frame in a horizontal direction.” Applicants respectfully submit that support for newly added claim 25 can be found in FIGS. 2, 3, 8, and 12, and the corresponding portions of the detailed description. Accordingly, it is respectfully submitted that new claim 25 does not present new matter, and is allowable over the prior art of record, and allowance of this claim is earnestly solicited.

New claim 26 also recites similar features as those recited in independent claims 1, 19, and 22, for example, “a frame having first and second covers to cover first and second

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openings, respectively," "a photosensitive drum to be installed in the frame through the first opening," and "a developing unit to be installed independently from the photosensitive drum in the frame through the second opening." Dependent claims 27-29 further define the structure of the printer as recited in independent claim 26. Applicants respectfully submit that support for newly added claims 26-29 can be found in FIGS. 2, 3, and 11-14 and the corresponding portions of the detailed description. Accordingly, it is respectfully submitted that new claims 26-29 do not present new matter, and are allowable over the prior art of record, and allowance of these claims are earnestly solicited.

Allowable Subject Matter

Claims 19-21 are allowed. Claims 6-13 and 23 have been objected to as being allowable if rewritten in independent form.

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Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

A \$650 fee for an additional claim has been incurred by this Amendment. If any further fees are required in connection with the filing of this amendment, please charge the same to out Deposit Account No. 502827.

Respectfully submitted,

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